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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,620	10/06/2005	Daniel Studer	1278-0168	9147
6449 7590 05/14/2008 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER CHOI, STEPHEN				
ART UNIT 3724		PAPER NUMBER		
NOTIFICATION DATE 05/14/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary

Application No.

10/552,620

Applicant(s)

STUDER, DANIEL

Examiner

Stephen Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) 6,9 and 10 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5,7,8 and 11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 06 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date 10/6/05
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species A in the reply filed on March 7, 2008 is acknowledged. The traversal is on the ground(s) that the restriction requirement fails to identify claims that are associated with each of the identified species and does not provide any reasons for the statement that each group lacks unity or specifically describe the unique technical features in each group. This is not found persuasive because the lack of unity of invention requirement is based on distinct species and MPEP does not require the examiner to identify claims that are associated with each of the species. Furthermore, the examiner has provided why each species lacks the same or corresponding special technical features on paragraph 3 of the previous office action. As set forth below, the independent claim 1 (the genus claim) does not avoid prior art, leaving claims joined thereby without a common inventive feature. Moreover, the applicant has indicated that claims 1-8 and 11 are readable on the elected species. The examiner respectfully disagrees. Claim 6 does not read on the elected species.

The requirement is still deemed proper and is therefore made FINAL.

Specification

2. The abstract of the disclosure is objected to because the use of legal phraseology. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-5, 7-8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are replete with vague and indefinite language and should be carefully reviewed. The following are examples of many of the occurrences of such language. Applicant is required to review and correct all the pending claims. Failure to do so may result in the next action made final.

In claims 1 and 5, the use of the phrase "may be" and "can be" should be avoided since it is confusing whether the recitations following the phrase are part of the claimed invention.

in claim 4, a broad range or limitation followed by linking terms (e.g., preferably) and a narrow range or limitation within the broad range or limitation is considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

In claim 5 and 7, it is not clear what structure is set forth by "approximately parallel".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 4-5, and 8 as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0924503 (hereafter '503).

'503 discloses all the recited elements of the invention including a cutter (e.g., 1), a cutter holder (e.g., 18), and a piezoelectric element (e.g., 31). Regarding claim 4, see page 2, lines 4-5. Regarding claim 5, page 3, lines 38-39. Regarding claim 8, a groove having two side walls and a groove base designed as an oblique surface, and the width of the groove being greater than the width of a blade holder (e.g., 16, 17, Figures 5-6).

7. Claims 1, 3, and 7, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by DE 3820085 (hereafter '085).

'085 discloses all the recited elements of the invention including a cutter (e.g., 18), a cutter holder (e.g., 12), and a piezoelectric element (e.g., 42). Regarding claim 3, a first supporting surface fastened on the cutter holder (e.g., Figure 9 at 62) and a second supporting surface fastened to the cutter (e.g., Figure 9, via 16).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 11, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over '085.

'085 discloses the invention substantially as claimed except for a second piezoelectric element. However, '085 teaches a piezoelectric element (e.g., 42) being provided on a sample holder (e.g., 22, Figure 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a second

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piezoelectric element as taught by '085 on the device of Figure 9 of '085 in order to facilitate cutting movement.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Leighton, Persson, and Studer are cited to show related devices.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Choi whose telephone number is 571-272-4504. The examiner can normally be reached on Monday-Thursday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen Choi/
Primary Examiner, Art Unit 3724
8 May 2008